

REMARKS

In the above referenced office action, Claims 1-15 and 17 are pending in the application. Claims 1-15 and 17 stand rejected. Claims 1 and 17 are being amended. New Claim 18 is being added. No new matter is being added.

Rejections Under 35 USC § 112

Claims 1 and 17 are rejected under 35 U.S.C. § 112 first paragraph because “the specification fails to provide an enabling disclosure to support the claimed limitation of having the PDA system be automatically synchronized”, and under second paragraph “as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.” These rejections have been traversed and reconsideration is hereby respectfully requested.

Claims 1 and 17 have been amended and thereby overcome the rejection under 35 USC § 112 first and second paragraphs. Applicant respectfully submits that this ground of objection is overcome thereby.

Rejections Under 35 USC § 103(a)

Claims 1-9 and 17 are rejected 103(a) as being unpatentable over Applicant's allegedly Admitted Prior Art (AAPA) in view of *Verdun et al.* (U.S. Patent 6,493,782). Claims 10-15 are rejected under 35 U.S.C. §103(a) as being unpatentable over Applicant's allegedly Admitted Prior Art (AAPA) in view of *Verdun*, as applied to claims 1-3 above, and further in view of *Smith, II* (U.S. 5,768,163). Applicants traverse this rejection on the grounds that these references are defective in establishing a *prima facie* case of obviousness.

As the PTO recognizes in MPEP §2142:

...The Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the Examiner does not produce a *prima facie* case, the Applicant is under no obligation to submit evidence of nonobviousness.....the Examiner must step backward in time and into the shoes worn by the hypothetical 'person of ordinary skill in the art' when the invention was unknown and just before it was made....The Examiner must put aside knowledge of the Applicant's disclosure, refrain from using hindsight, and consider the subject matter claimed 'as a whole.'"

Regarding Claims 1 and 17, Applicants have amended Claims 1 to recite "the PDA chassis being mounted in the PC chassis whereby the PDA system is coupled with the PC system to receive power, input and display" and "the PDA chassis being removed from the PC chassis at any time including the PC system and the PDA system being in an off, on or running mode, whereby the PDA system operates independently of the PC system including the power, input and display". Claim 17 has been amended to include similar limitations.

Office Action acknowledges that AAPA does not teach or suggest above referenced limitations. The Office Action, however, asserts that "Verdun teaches a portable computer (PDA chassis) that is automatically synchronized to its expansion unit (PC chassis), the PDA chassis being able to be removed from its PC chassis at any time including being in an off, on or running mode, whereby the PDA automatically transitions into an independent its own self-contained system to operate independently of the PC system including power, input and display [column 2 lines 38-57 and column 2, line 66 to column 3 line 5] for the benefit of being able to connect and disconnect the portable computer in all power state configurations".

Verdun teaches a docking technique to dock a portable computer (equivalent to a PDA chassis, per office action) with an expansion unit (equivalent to a PC chassis,

per office action). However, Verdun does not teach or suggest the portable computer and the expansion chassis continue to operate independently including power, input and display when the portable computer and the expansion chassis are undocked. On the contrary, Verdun (column 6 lines 45-48, column 8 lines 21-24) teaches away from limitations of Claims 1 and 17, by teaching the expansion unit is powered down when the portable computer and the expansion chassis are undocked. As such, there would be no motivation to combine the teachings of AAPA and Verdun.

Thus, AAPA and Verdun considered individually or in combination do not teach or suggest each and every element of the claimed invention. Therefore, the Office Action fails to establish a *prima facie* case of obviousness.

The MPEP §2143.01 provides:

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

Therefore, the Examiner's combination arises solely from hindsight based on the invention without any showing of suggestion, incentive or motivation in either reference for the combination.

Thus, the Examiner's burden of factually supporting a *prima facie* case of obviousness has clearly not been met.

The Federal Circuit has, on many occasions, held that there was no basis for combining references to support a 35 U.S.C. §103 rejection. For example, in *In re Geiger*, the court stated in holding that the PTO "failed to establish a *prima facie* case of obviousness":

Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. *ACS Hospital Systems, Inc. v. Monteffiore Hospital*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984).

The Federal Circuit has also repeatedly warned against using the Applicant's disclosure as a blueprint to reconstruct the claimed invention out of isolated teachings in the prior art. See e.g., *Grain Processing Corp. v. American Maize-Products*, 840 F.2d 902, 907, 5 USPQ2d 1798, 1792 (Fed. Cir. 1989).

More recently, the Federal Circuit found motivation absent in *In re Rouffet*, 149 F.3d 1350, 47 USPQ2d 1453 (Fed. Cir. 1998). In this case, the court concluded that the board had "reversibly erred in determining that one of [ordinary] skill in the art would have been motivated to combine these references in a manner that rendered the claimed invention [to have been] obvious." The court noted that to "prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the Examiner to show a motivation to combine the references that create the case of obviousness." The court further noted that there were three possible sources for such motivation, namely "(1) the nature of the problem to be solved; (2) the teachings of the prior art; and (3) the knowledge of persons of ordinary skill in the art." Here, according to the court, the board had relied simply upon "the high level of skill in the art to provide the necessary motivation," without explaining what specific understanding or technological principle within the knowledge of one of ordinary skill in the art would have suggested the combination. Notably, the court wrote: "If such a rote invocation could suffice to supply a motivation to combine, the more sophisticated scientific fields would rarely, if ever, experience a patentable technical advance."

New Claim 18 recites "a switch coupled to the PC system and the PDA system, wherein the PC system and the PDA system operate independently of each other when uncoupled and share power when coupled, wherein the switch selects one of the PC system and the PDA system". For reasons similar to those stated in regard to Claims 1 and 17, new Claim 18 is allowable for at least this reason.

Therefore, independent claims 1, 17 and 18, and the claims 2-15, which dependent therefrom are submitted to be allowable.

In view of the above, it is respectfully submitted that claims 1-15, and 17-18 are in condition for allowance. Accordingly, an early Notice of Allowance is courteously solicited.

Respectfully submitted,



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